REMARKS

In the Office Action mailed September 23, 2008, the Examiner rejected claim 25 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, and rejected claims 1-22 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 7,035,856 to Morimoto.

By this amendment, Applicant amends claim 15 to more clearly define the features of that claim and cancels claim 25 without prejudice or disclaimer.

Claims 1-24 are currently pending.

At the outset, Applicant respectfully submits that the rejections violate 35 U.S.C. § 132 and are thus improper because the explanation that the Examiner provides lacks sufficient specificity. 35 U.S.C. § 132 provides, in relevant part, that "whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application." A claim rejection violates 35 U.S.C. § 132 if it "is so uninformative that is prevents the applicant from recognizing and seeking to counter the grounds for rejection." Chester v. Miller, 906 F.2d 1574, 1578, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990). Indeed, the Examiner merely makes general comments without expressly referring to claims 1-22. More troubling, the Examiner completely ignored claims 23-24. In view of the foregoing, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Regarding the rejection under 35 U.S.C. § 112, first paragraph, Applicant has canceled, without prejudice or disclaimer, claim 25, obviating the basis of this rejection.

The Examiner rejected claims 1-22 under 35 U.S.C. § 103(a) as unpatentable over

Morimoto. Applicant respectfully traverses this rejection.

Claim 1 defines a method of tracking medical or toxic waste. The method includes "monitoring the movement of a first container having a wireless tracking device attached thereto from a waste generating facility to a waste treatment facility using the wireless tracking device." In contrast, Morimoto merely discloses tracking shipped items, without any suggestion or disclosure regarding medical waste. To address that gap in Morimoto, the Examiner states:

> The medical waste management industry, to one of ordinary skill in the art, for sometime now hospitals have placed waste in proper containers for disposal, separated into different but like categories and been charged for its proper disposal.

Office Action, page 4. Applicant disagrees and submits that the Examiner has improperly used *Official Notice*, and, as such, requests that the Examiner either provide evidence to support his position or withdraw the rejection under 35 U.S.C. §103(a).[1]

Moreover, the Examiner alleges the following:

> Also it should be noted as to the system claims Morimoto teaches nearly the identical system but does not teach the specific goods/waste shipped and recited in the claimed invention. However, the specific goods shipped in the containers does not patentably distinguish the claimed system. Further, the recited statement of intended -use, does not patentably distinguish the claimed system.

Office Action, page 4. However, functional language must be considered by the Examiner. The M.P.E.P. states:

[1] It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. M.P.E.P 2144.03.

> A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).
>
> A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. >In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated function." "In the absence of modifiers, general descriptive terms are typically construed as having their full meaning." *Id.* at 1118, 72 USPQ2d at 1006. In the patent claim at issue, "subject to any clear and unmistakable disavowal of claim scope, the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." *Id.* at 1120, 72 USPQ2d at 1008.<

M.P.E.P. 2173.05(g).

Moreover, the position taken by the Examiner regarding "statement of intended use," is inapposite to method claims. See, e.g., M.P.E.P. 2144.

In view of the foregoing, Morimoto fails to suggest or disclose at least the following feature of claim 1 "monitoring the movement of a first container having a wireless tracking device attached thereto from a waste generating facility to a waste treatment facility using the wireless tracking device." Therefore, claim 1 is allowable over Morimoto, and the rejection under 35 U.S.C. § 103(a) of claim 1 and claims 2-14 and 23-24, at least by reason of their dependency from allowable claim 1, should be withdrawn.

Moreover, claim 15 recites a combination of elements including, among other things, "a tracking station capable of monitoring the movement of the medical waste by tracking the wireless tracking device and, when the waste is destroyed, calculating an

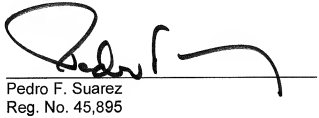
amount representative of what is owed based on a type of the medical waste and a weight of the medical waste." For at least the reasons noted above, Morimoto is silent with respect to this feature, and the Examiner's modifications of Morimoto do not cure this gap in the Morimoto disclosure. Therefore, claim 15 and claims 16-22, at by reason of their dependency from allowable claim 15, are allowable over Morimoto, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

CONCLUSION

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. No fee is believed to be due, however, the Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 36707-502.

Respectfully submitted,



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